

40098



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

AXEL SCHULTE

Serial No.: **09/601,280**

Filed: **July 31, 2000**

For: **FLOOR CARPET INSTALLING
SYSTEM**

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Art Unit: **1771**

Examiner: **C. A. JUSKA**

Appeal No. _____

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the December 10, 2004 Notification of Non-Compliant Appeal Brief (37 C.F.R. § 41.37) in connection with the above-identified application, a Second Conditional Brief on Appeal is submitted herewith, to avoid abandonment while applicant's concurrently filed petition is considered. All necessary fees were previously paid.

The enclosed Brief complies with 37 C.F.R. § 41.37. The references to the substitute specification are presented with a strikethrough.

Additionally, applicant submits that this objection to the originally filed brief is improper and unfair since the previously submitted brief was in substantial compliance with the new rules, since the prior Notification did not raise this objection, and since the submission of the September 24, 2004 brief involved a corrected brief filed while a petition is under consideration.

Respectfully Submitted,



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Dated: Dec. 16, 2004

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In re Application of:

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Art Unit: **1771**

Examiner: **C. A. JUSKA**

Appeal No. _____

SECOND CONDITIONAL BRIEF ON APPEAL

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APPENDIX A - COPY OF CLAIMS ON APPEAL

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40098

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	
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AXEL SCHULTE	:	Art Unit: 1771
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SYSTEM	:	

SECOND CONDITIONAL APPELLANT'S
BRIEF ON APPEAL UNDER 37 C.F.R. § 1.192

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the December 10, 2004 Notification of Non-Compliant Appeal brief and for the appeal to the Board of Patent Appeals and Interferences from the decision dated March 19, 2003 of the Primary Examiner finally rejecting claims 10-25 and 27 in connection with the above-identified application, Applicant-Appellant submits the following brief in accordance with 37 C.F.R. § 41.37.

1. Real Party in Interest

The inventor, Axel Schulte, assigned his entire right, title and interest in the patent application to Gottlieb Binder GmbH & Co. of Holzgerlingen, Germany.

2. Related Appeals and Interferences

There are no other related appeals or interferences known to Appellant, Appellant's legal representative, or assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal.

3. Status of Claims

Claims 10-25 and 27 are pending, are rejected, and are on appeal.

4. Status of Amendments

Two Amendments were filed subsequent to the March 27, 2003 Office Action. The June 19, 2003 Amendment was refused entry pursuant to September 25, 2003 Advisory Action. The September 17, 2003 Amendment was entered pursuant to the October 21, 2003 Advisory Action.

5. Summary of the Invention

The present invention of independent claim 10 relates a floor carpet installation system comprising a carpet 1 and 3, a floor loopless material 21 and a micro-adhesive closing element 7.

The carpet has a nap side forming its usable surface and has a backside formed of a carpet loopless material 5 opposite the nap side. The floor loopless material is fixable to a floor surface 25. The micro-adhesive closing element 7 has opposite carpet and floor surfaces, with each surface having protruding interlocking elements 11. Elements 11 on the carpet and floor surfaces of the closing element interlock with the carpet and floor loopless materials, respectively. The interlocking elements are configured as fingers with thicknesses 13 at their free ends. The

interlocking elements on the carpet surface have different shapes, different dimensions and/or different relative adjacent spacings relative to the interlocking elements on the floor surface.

By forming the carpet insulation system in this manner, both the connection between the closing element and the carpet backside loopless material 5 and the connection between the closing element and the floor loopless material 21 are releasable. The differences between the interlocking elements on the carpet surface and on the floor surface provide different connection strengths at each of the respective interfaces to facilitate the desired removable.

6. Grounds for Rejection to be Reviewed on Appeal

Claims 15 and 16 stand rejected as being unpatentable under the judicially created doctrine of obviousness type double patenting over claim 1 of co-pending Application No. 09/601,279.

Claims 10-25 and 27 stand rejected as being unpatentable under 35 U.S.C. § 112, first paragraph for reciting "said interlocking elements on said carpet side having at least one of different shapes, different dimensions and different relative spacings relative to said interlocking elements on said floor surface" on the ground that the specification fails to describe such subject matter in a way to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claims 10-14, 19-25 and 27 stand rejected as being unpatentable under 35 U.S.C. § 103 over DE 195 32 685 to Leopold in view of DE 196 46 318 to Hammer, U.S. Patent No. 5,753,336 to Stull and U.S. Patent No. 6,298,624 to Pacione.

Claims 10-14, 19-25 and 27 stand rejected unpatentable under 35 U.S.C. § 103 over U.S. Patent No. 6,298,624 to Pacione in view of DE 196 46 318 to Hammer.

7. Argument

A. The Provisional Double Patenting Rejection Is Untenable for Failing to Consider Limitations of Parent Claims

Claims 15 and 16 are provisionally rejected on the grounds of obviousness-type double patenting over claim 1 (presumably intended to refer to claim 7) of co-pending application No. 09/601,279. The rejection cannot be based on claim 1 of that co-pending application since that claim 1 has been cancelled.

Claims 15 and 16, being dependent upon claim 10 (indirectly) include the limitations of claim 10, which limitations admittedly patentably distinguish claim 1 (or 7) of the co-pending application. Specifically, the co-pending application is distinguished by the recitation of the protruding interlocking elements on each of the two opposite surfaces of the closing element, with the elements on the different surfaces having different shapes, dimensions or relative spacings.

Since the statement of the final rejection refers to claim 1 (the sole independent claim of the original co-pending application), claim 1 has been cancelled and claim 7 is presently the sole independent claim of that co-pending application, the double patenting rejection will be considered relative to that claim 7. The double patenting rejection cannot be based on a cancelled claim.

Claim 7 of the co-pending application presently reads as follows:

7. A floor carpet installation system, comprising:
a carpet having a nap side forming a useful surface thereof and having a backside opposite said nap side;
a loopless material fixed on said backside of said carpet; and
a micro-adhesive closing component fixable to a floor and having upwardly protruding mushroom-shaped interlocking elements on a carrier, said interlocking elements having fingers with mushroom-shaped heads at ends thereof remote from said carrier interlockingly engaged with said loopless material, said heads having concave

depressions on top surfaces thereof receiving adhesive to provide an additional connection with said backside of said carpet.

For this obvious-type double patenting, the Examiner must present a prima facie case that claims 15 and 16 of this application are merely an obvious variation of the invention claimed in the co-pending application. In re Kaplan, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). See also, e.g., Ex parte Davis, 56 USPQ 2d 1434 (B.P.A.I. 2000) (non-precidential). Such rejection is only appropriate when the claimed subject matter is not patentably distinct from the claims of the other patent or patent application so as to provide an unjustified extension of the patent term. General Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992). M.P.E.P. § 804. Since both applications were filed on the same day, no unjustified extension of the patent term is possible.

Claim 7 of the co-pending application only recites a micro-adhesive closing component with upwardly protruding interlocking elements, and thus, only recites interlocking elements on one surface of the carrier. No portion of claim 7 recites or renders obvious interlocking elements on each of the two opposite surfaces of the closing element or interlocking elements having different shapes, dimensions and spacings on the opposite surfaces. These two features are recited in claim 10 of this application upon which claims 15 and 16 indirectly depend. Because of this dependency, claims 15 and 16 include these features, which must be considered. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). These features are not treated in any manner in the final rejection. The mere recitation of some common features fails to inadequately provide a prima facie case of obviousness, as required. The failure of the rejection to treat all of the limitations of the claims in issue and the failure to reject claim 10 for double patenting render the double patenting rejection untenable .

Accordingly, this provisional obviousness-type double patenting rejection is untenable and should be reversed.

B. Rejection Under 35 U.S.C. § 112 Is Untenable
Since Claimed Features are Adequately Disclosed

Claims 10-27 are rejected under 35 U.S.C. § 112, first paragraph, on the ground that the specification does not adequately disclose interlocking elements having one of different shapes, different dimensions and different relative adjacent spacings on the opposite surfaces of the closing element.

However, such different spacings are clearly illustrated in Fig. 1, as admitted by the Examiner in the October 21, 2003 Interview Summary. The drawings need not illustrate all embodiments covered by the claim. The different shapes, dimensions and/or spacings are clearly recited in claim 1 (last two lines) as modified in the Preliminary Examination, and are discussed in the second full paragraph of page 2 of the modified sheets. ~~Such feature is also described on page 3, lines 3-5, of the substitute specification.~~

The claim need not be limited to a single embodiment, particularly the preferred embodiment of Fig. 1. The drawings are merely one practical example of the invention and need only show a reasonable number of species (here one) to support a genus claim where the technology is predictable. Lampi Corp. v. American Power Products Inc., 228 F.3d 1365, 1378, 56 USPQ2d 1445, 1455 (Fed. Cir. 2000). See also, Moba B.V. v. Diamond Automation Inc., 325 F.3d 1306, 66 USPQ2d 1429 (Fed. Cir. 2003).

Thus, this recitation in claim 10 is adequately supported in the application ~~and is described in the specification~~ in such a way as to reasonably convey to one skilled in the relevant

art that the inventor, at the time the application was filed, had possession of the claimed invention. Also, this claim 10 recitation allows one skilled in the art to visualize or recognize the identity of the claimed subject matter, particularly since the pertinent art is predictable.

C. Rejections of Claim 10 Under 35 U.S.C. § 103
Do Not Provide Prima Facie Case of Obviousness

Claims 10-14 and 19-27 stand rejected under 35 U.S.C. § 103 as being unpatentable over DE 195 32 685 to Leopold in view of DE 196 46 318 to Hammer, U.S. Patent No. 5,753,336 to Stull and U.S. Patent No. 6,298,624 to Pacione. The Leopold patent is cited for a floor covering 1 having a lower felt layer 2, and an underlayer glued to the floor substrate 5 that engages the lower felt layer 2. The Hammer patent is cited for the use of hooks with concave depressions. The Stull patent (Figs. 7 and 8) and the Pacione patent (Fig. 31) are cited for the use of a closing element having hooks on each of its two sides to provide an attachment between a floor substrate and a carpet substrate. In support of the rejection, it is contended that it would be obvious to form the Leopold hooks as disclosed in the Hammer patent and to use a double-sided hook and underlay material in view of the Stull and Pacione patents. The use of hooks of different shapes, dimensions or spacings on the two surfaces is considered obvious without citation of evidence in support thereof.

However, this combination of four patents is unduly complex indicating the claimed invention is non-obviousness. Also, the different shapes, dimensions or spacings is not obvious without any teaching thereof.

Claims 10-14 and 19-27 are also rejected under 35 U.S.C. § 103 as being unpatentable over the Pacione patent in view of the Hammer patent. Figure 31 of the Pacione patent is again

relied upon for allegedly disclosing a double-sided hook anchor sheet. In support of the rejection, it is contended it would be obvious to use the Hammer hook configuration on the Pacione anchor sheet. Again, it is contended that it would be obvious to have the hooks on the opposite surfaces with different shapes, dimensions or spacings without citation of evidence in support thereof.

These two rejections under 35 U.S.C. § 103 are improper since no evidence of record supports the contention that it would be obvious to provide different hook arrangements on the opposite sides of the closure element or anchor sheet. The only suggestion for providing these differences comes from the instant application which has a significant advantage resulting from the difference, i.e., the different connection strengths at the two interfaces to facilitate the removal between the carpet and the closing element or between the closing element and the loopless material fixable to the floor.

The Leopold DE patent discloses a carpet installation system having an underlayer 4 glued to the floor surface 5. Underlayer 4 has a plurality of hook or mushroom formed interlocking elements which extend upwardly from its upper surface, and engage a felt layer 2 attached to the undersurface of carpet 1. The felt layer 2 is fixed to the underside of carpet layer 1.

Since the Leopold underlayer 4 only has interlocking elements extending upwardly from its upper surface, it does not have or render obvious the use of a closing element in a carpet installation system having interlocking elements extending from each of the two opposite surfaces of the closing element. Particularly, it does not disclose a micro-adhesive closing element having different interlocking element configurations on each of its two opposite surfaces to provide different connections with two different loopless materials. In the present claimed

invention, different removable connections are provided between the carpet and the adhesive closing element and between the adhesive closing element and the floor loopless material.

The German Hammer patent is only cited in connection with the micro-adhesive closing element having hooks with concave depressions in their tops. It is not cited relative to the above discussed Leopold DE patent deficiencies regarding the interlocking elements on both sides and regarding the different configurations on both sides of the adhesive closing element.

The Stull patent discloses a removable underlay 60 for rugs having a firm layer 16 with loop or needle punched material 62 on one side attachable to hook material 65 and with nibs 26 on an opposite side attachable to filaments 32' of carpet C'. While loop material 62 may be viewed as having interlocking elements, nibs do not constitute interlocking elements configured as fingers with thicknesses at their free ends. Thus, the Stull patent does not teach interlocking elements on opposite surfaces of a closing element, as claimed in this application.

The Pacione patent, in Fig. 31, discloses an anchor sheet module 219 with an upper layer 223 having hooks on its upper surface 220 and its lower surface 224. However, the hooks on the upper and lower surfaces appear to be identical. No portion of the Pacione patent is cited as disclosing that the hooks on the upper and lower surfaces have different shapes, dimensions or spacings as claimed. The Hammer patent, as noted above, does not supply this deficiency in the Pacione patent.

When no reference discloses a feature of a claim relied on to distinguish the prior art, there can be no suggestion to modify the prior art to contain that feature. In re Civitello, 339 F.2d 243, 144, USPQ 10 (C.C.P.A. 1964). As stated in W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1551, 220 USPQ 303, 311 (Fed. Cir. 1983), there must be something in the teachings of the cited patents to suggest to one skilled in the art that the claimed

invention would be obvious. Here, there is no teaching in the Stull and Pacione patents, or in any other cited patent, of the claimed interlocking elements of different spaces, dimensions or spacings on the opposite surfaces of the closing element. Thus, the rejection is not adequately supported by a clear factual basis, as required. In re Warner, 379 F.2d 1011, 154 USPQ 173 (C.C.P.A. 1967).

Accordingly, claim 10 is patentably distinguishable over the cited patents.

D. Dependent Claims are Further Distinguished

Claims 11-27, being dependent upon claim 10 are also allowable for the above reasons. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents.

(1) Claim 11

Claim 11 is further distinguished by the recited mushroom-shaped heads.

(2) Claim 12

Claim 12 is further distinguished by the recited plate-shaped heads.

(3) Claims 13 and 14

Claims 13 and 14 are further distinguished by the recited concave depressions.

(4) Claims 15-16

Claims 15 and 16 are further distinguished by the recited adhesive in the depressions.

(5) Claims 17-18

Claims 17 and 18 are further distinguished by the adhesive having an acrylate base.

(6) Claim 19

Claim 19 is further distinguished by the loopless material being a felt.

(7) Claim 20

Claim 20 is further distinguished by the loopless material being a fleece.

(8) Claim 21

Claim 21 is further distinguished by the loopless material being a fabric.

(9) Claim 22

Claim 22 is further distinguished by the loopless material being a woven textile.

(10) Claim 23

Claim 23 is further distinguished by the loopless material being a non-woven textile.

(11) Claim 24

Claim 24 is further distinguished by the loopless material being a synthetic material.

(12) Claim 25

Claim 25 is further distinguished by the loopless material being a needle punched felt.

(13) Claim 26

Claim 26 is further distinguished by the loopless material being a tuft.

(14) Claim 27

Claim 27 is further distinguished by the loopless material being footstep-sound-absorbing properties.

9. Conclusion

In view of the foregoing, Applicant-Appellant submits that (1) the rejection of claims 15 and 16 for obvious type double patenting, (2) the rejection under 35 U.S.C. § 112, first paragraph, of claims 10-25 and 27, (3) the rejections under 35 U.S.C. § 103 of claims 10-14, 19-25 and 27 are untenable. Thus, Applicant-Appellant requests that these rejections be reversed.

Respectfully Submitted,



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Dated: Dec 16, 2004

APPENDIX A - COPY OF CLAIMS ON APPEAL

10. A floor carpet installation system, comprising:
 - a carpet having a nap side forming a usable surface thereof and having a backside formed of a carpet loopless material opposite said nap side;
 - a floor loopless material fixable to a floor surface; and
 - a micro-adhesive closing element having opposite carpet and floor surfaces, each of said surfaces having protruding interlocking elements, said elements on said carpet and floor surfaces interlocking with said carpet and floor loopless materials, respectively, said interlocking elements being configured as fingers with thicknesses at free ends thereof, said interlocking elements on said carpet surface having at least one of different shapes, different dimensions and different relative adjacent spacings relative to said interlocking elements on said floor surface.
11. A floor carpet installation system according to claim 10 wherein said thicknesses of said interlocking elements comprise mushroom-shaped heads.
12. A floor carpet installation system according to claim 10 wherein said thicknesses of said interlocking elements comprise plate-shaped heads.
13. A floor carpet installation system according to claim 11 wherein said heads have concave depressions on tops thereof.
14. A floor carpet installation system according to claim 12 wherein said heads have concave depressions on tops thereof.

15. A floor carpet installation system according to claim 13 wherein said depressions in said heads on said interlocking elements on at least one of said surfaces receives adhesive to provide an additional connection with one of said carpet loopless material and said floor loopless material.

16. A floor carpet installation system according to claim 14 wherein said depressions in said heads on said interlocking elements on at least one of said surfaces receives adhesive to provide an additional connection with one of said carpet loopless material and said floor loopless material.

17. A floor carpet installation system according to claim 15 wherein said adhesive comprises an acrylate base.

18. A floor carpet installation system according to claim 16 wherein said adhesive comprises an acrylate base.

19. A floor carpet installation system according to claim 10 wherein said loopless materials comprise felt.

20. A floor carpet installation system according to claim 10 wherein said loopless materials comprise fleece.

21. A floor carpet installation system according to claim 10 wherein said loopless materials comprise a loose leno weave.
22. A floor carpet installation system according to claim 10 wherein said loopless materials comprise a flat knit.
23. A floor carpet installation system according to claim 10 wherein said loopless materials comprise non-woven textile.
24. A floor carpet installation system according to claim 23 wherein said non-woven textile is synthetic material.
25. A floor carpet installation system according to claim 23 wherein said non-woven textile is needle punched felt.
27. A floor carpet installation system according to claim 10 wherein said floor loopless material comprises footstep-sound-absorbing properties.

APPENDIX B - EVIDENCE

None

APPENDIX C - RELATED PROCEEDINGS

None